IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	:	Attorney Docket No.: 23452-078
	:	
Douglas W. CONMY, *et al.*	:	Group Art Unit: 2172
	:	
Serial No.: 09/345,448	:	Examiner A. Ly
	:	
Filed: July 1, 1999	:	

For: SYSTEM AND METHOD FOR ENABLING A USER TO SUBSCRIBE TO
        UPDATES FROM INFORMATION SOURCES

APPELLANTS' BRIEF ON APPEAL UNDER 37 C.F.R. §1.192 *(AMENDED)*

ATTN: Board of Patent Appeals and Interferences
The Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Further to the Conditional Notice of Appeal filed on September 19, 2001,
Appellants' herewith submit Appellants' Brief on Appeal in triplicate pursuant to 37
C.F.R. §1.192(a).

In accordance with §1.17(c), a check in the amount of $320.00 representing the
fee for filing an Appeal Brief was previously submitted on November 19, 2001. It is
believed that no other fees are due in connection with this submission, however, if it is
determined otherwise, Commissioner is authorized to credit any overpayment or charge
any deficiencies to the undersigned's account, Deposit Account No. 50-0311.

(1) REAL PARTY IN INTEREST

By virtue of the assignment recorded July 1, 1999 at reel 010097, frame 0840, the
real party in interest is **International Business Machines**, a New York corporation
having a place of business in Armonk, New York.

(2) RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

(3) STATUS OF THE CLAIMS

Claims 1, 6, 11, and 16 stand rejected under 35 USC § 103(a) as allegedly being unpatentable over a U.S. Patent Number 5,311,572 issued to Friedes *et. al.* ("Friedes") in view of U.S. Patent Number 6,125,388 issued to Reisman ("Reisman"). Claims 2-3, 7-8, 14-15, and 17-18 stand rejected under 35 USC § 103(a) as allegedly being unpatentable over Friedes in view of Reisman and further in view of U.S. Patent Number 6,141,653 issued to Conklin *et. al.* ("Conklin"). Claims 4, 9, 12, 19, and 21-32 stand rejected under 35 USC § 103(a) as allegedly being unpatentable over Friedes in view of Reisman and further in view of U.S. Patent Number 6,020,980 issued to Freeman ("Freeman"). Claims 5, 10, and 20 stand rejected under 35 USC § 103(a) as allegedly being unpatentable over Friedes in view of Reisman and further in view of U.S. Patent Number 5,038,601 issued to Lambert *et. al.* ("Lambert").

Claim 13 is also pending, however, claim 13 has not been rejected, objected to, or allowed. Appellants respectfully request that an Office Action specifically acting on claim 13 be issued. Therefore, claims 1-32 are pending.

(4) STATUS OF AMENDMENTS

Appellants have not amended the claims subsequent to a Final Office Action dated June 19, 2001 ("Office Action").

(5) SUMMARY OF THE INVENTION

A system, method, and computer usable medium containing computer readable program code are provided that provide a user with information updates related to topics of interest through various information sources. Those sources may include, for example, software applications provided over a network, software applications on a local computer, etc. The system may perform a search of one or more object stores, for instance, servers located on the Internet, accessed by client applications to retrieve information requested by a user.

The invention includes a set of objects for information retrieval and related functions to filter and deliver desired updates from object stores. Those objects generally comprise software modules running on a general purpose programmed computer. For instance, the system may include a request object for requesting a subscription to information produced by one or more object stores accessed by a client application. The subscription contains a request for ongoing updates to information related to a particular topic. Preferably, the subscription(s) are created while the object stores desired to be searched are active. A presenting object may be used to present a subscription request view to a user and enable the user to request the subscription. The system may also include a criteria request object that requests a user to input a search criteria for performing the search. A criteria receiving object may be used to receive the criteria input by a user. A submit request object may then be used to submit the subscription to the system. After receiving the subscription, the system may perform periodic searches of the object stores accessed by the computer application to retrieve information satisfying the search criteria input by the user.

According to the specific embodiment, a user may open a computer application, for example, an electronic mail or calendar application. The user may select, for example, a "Create button from a pull-down field and select a "Subscription" option. If "Subscription" is selected from the "Create" pull-down menu, a subscription view is presented that permits the user to create a subscription, based on selected search criteria, to that object store. For example, if a user creates a subscription while having a mail application active, the user may create a subscription for electronic mail messages containing predetermined text, from a particular sender, or other criteria. For example, a user may create a subscription for electronic mail messages containing the word "paycheck."

The system then performs periodic searches of electronic mail messages received (either randomly or at times assigned by the user or by other known mechanisms) to determine whether the messages contain the word "paycheck." If "paycheck" appears in a message, the update system notifies the user that a message containing the word "paycheck" has been received (*e.g.*, by presenting the message or a portion in a

subscription window). Additionally, the update system may ask the user whether the message should be presented immediately.

(6) ISSUES

1. Whether claims 1, 6, 11, and 16 are unpatentable, under 35 U.S.C. § 103(a), over U.S. Patent No. 5,311,572 issued to Friedes *et al.* ("Friedes") in view of U.S. Patent No. 6,125,388 issued to Reisman ("Reisman").

2. Whether claims 2-3, 7-8, 14-15, and 17-18 are unpatentable, under 35 U.S.C. § 103(a), over Friedes in view of Reisman and further in view of U.S. Patent No. 6,141,653 issued to Conklin *et al.* ("Conklin").

3. Whether claims 4, 9, 12, 19, and 21-32 are unpatentable, under 35 U.S.C. § 103(a), Friedes in view of Reisman and further in view of U.S. Patent No. 6,020,980 issued to Freeman ("Freeman").

4. Whether claims 5, 10, and 20 are unpatentable, under 35 U.S.C. § 103(a), over Friedes in view of Reisman and further in view of U.S. Patent No. 5,038,601 issued to Lambert *et al.* ("Lambert").

(7) GROUPING OF CLAIMS

Claims 1-12 and 14-32 are separately patentable. Therefore, claims 1-12 and 14-32 do not stand or fall together. Arguments for the separate patentability of each claim are provided below.

(8) ARGUMENT

For each of the above three issues the question to be resolved is whether the asserted rejection is a proper rejection under 35 U.S.C. § 103(a). Appellants respectfully submit that each of the asserted rejections are improper for at least failing to teach all the suggested claim limitations and because proper motivation to combine the references has not been provided. Appellants provide below a discussion of the requirements for a

prima facie case of obviousness under 35 U.S.C. §103(a) and an application of these requirements to each claim.

Requirements for prima facie case of obviousness

As stated in the MPEP § 2143, three requirements must be met to establish a *prima facie* case of obviousness under 35 U.S.C. 103(a). The requirements are: (1) the prior art must teach or suggest all the claim limitations, (2) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings, and (3) there must be a reasonable expectation of success.

Appellants respectfully submit that at least the first two requirements are not met by the asserted rejections. Therefore, Appellants examine those requirements in further detail.

All of the claim limitations must be taught or suggested

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Suggestion or Motivation to modify the references

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Claim 1

Appellants respectfully submit that the rejection of claim 1 as allegedly being unpatentable under 35 U.S.C. § 103 (a) over Friedes in view of Reisman is improper for

failing to teach or suggest every claimed feature, failing to provide an adequate motivation for combining the references, using improper hindsight, and using non-analogous art.

Claim 1 recites, *inter alia*, "subscription requesting means for enabling a user to request a subscription of *at least one non-web document* from at least one database, *wherein the subscription identifies information to be searched for and presented to the user at various intervals without additional user intervention.*" Neither Friedes nor Reisman disclose or suggest a subscription that identifies information to be searched for and presented to the user at various intervals without additional user intervention.

As admitted in a Final Office Action, mailed June 19, 2001 (Office Action), "Friedes does not disclose explicitly indicate 'the subscription identifies information to be searched for and presented to the user at various intervals without additional user intervention.'" Office Action, ¶ 4 (p. 3).

Reisman is relied upon as allegedly disclosing "the user at various interval without additional user intervention." Office Action, ¶ 4 (p. 3). The Office Action refers Appellants' attention to column 10, lines 62-67 and column 11, lines 1-63. Reisman, however, does not appear to disclose a system for providing a subscription to "at least one non-web document" as claimed. Reisman appears to disclose a system for transporting information objects between a user station and multiple remote sources. Any documents, however, that may be transported using the system disclosed in Reisman appear to be in a web format. Reisman states at column 32, lines 30-31, that the content type may be "multimedia formats, video formats, sound formats and *hypertext markup language*." Hypertext markup language is a format used for publishing documents on the World Wide Web (WWW). Therefore, any <u>document</u> that is transported using the system disclosed in Reisman appears to be a web document. Thus, Reisman does not appear to disclose a system for providing a subscription to "at least one non-web document" as claimed.

In an Advisory Action mailed October 1, 2001 (Advisory Action), the Examiner states that Applicants do not specifically define what a "non-web document" is in Applicants' specification. Appellants respectfully submit that one of ordinary skill in the

art understands what is meant by a "non-web document." As one of ordinary skill in the art is aware, documents may be provided in a format such that the documents may be published on the WWW. For a document to be published on the WWW, the document must be in a format that is viewable by users of the WWW. If a document is not in an acceptable format, users of the WWW are not able to view the document. A document that is viewable to users of the WWW is a web document. Therefore, documents that are not in a format viewable to users of the WWW are non-web documents. Appellants respectfully submit that one of ordinary skill in the art understands this distinction and that Appellants are not attributing any special meaning to the term "non-web document."

Appellants respectfully submit that the rejection of claim 1 is improper because the Friedes and Reisman fail to disclose or suggest at least the claimed feature of *subscription requesting means for enabling a user to request a subscription of at least one non-web document* from at least one database, *wherein the subscription identifies information to be searched for and presented to the user at various intervals without additional user intervention.*

Appellants respectfully submit that the asserted rejection of claim 1 is also improper for failing to provide motivation to combine the teachings of the references. The Office Action alleges that "it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Friedes with the teachings of Reisman so as to have a system for enabling a system user to request a subscription of at least one non-web document from at least one database because the combination would provide an information system with any of multiple electronic information object such as e-mail, web page, or non-web document for mass distribute to the requested subscriber as a user (Friedes – col. 5, lines 1-29) in the user to subscribe to updates from information resources environment." Office Action, ¶ 4 (p.5). As evidenced by the reason for combining the teachings of the references, improper hindsight has been used to arrive at Applicants' claimed invention.

Assuming *arguendo* that Reisman cures the deficiencies of Friedes, there is no motivation to combine Friedes and Reisman. Friedes discloses "a system for processing a database-queried call uses the call processing capabilities of a carrier's database and a

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subscriber's database as part of a total communication switching system." *See,* Abstract. Friedes describes database-queried communications services as "800 and 900 services which require information look-up in order to route each call." Column 1, line 16-18. Friedes, therefore, is directed to "allow database-queried telephone calls to be efficiently handled and completed using in a cooperative manner, the aggregate call processing capabilities of a subscriber's database and a carrier's database as part of a total communications switching system." Column 4, lines 4-8. A subscriber as described in Friedes appears to relate merely to a telephone subscriber. The subscriber may not request a subscription for non-web documents from a database that are search for and presented to the user at various intervals without additional user intervention as claimed. "The subscriber's database uses information from diverse sources to formulate a processing label for the call." Column 4, lines 15-17. Friedes uses information in a database to route a call. This information, however, is not a subscription to which a telephone subscriber may subscribe. Friedes is not directed to a system for providing a subscription to at least one non-web document as claimed.

Reisman, however, appears to relate to a system for transporting information objects between a user station and multiple remote sources. Nowhere does Reisman appear to disclose a system for routing database-queried calls as disclosed by Friedes. One of ordinary skill in the art would not look to Reisman to modify Friedes. Therefore, there is no motivation to combine Friedes and Reisman.

Appellants further respectfully submit that Friedes and Reisman are non-analogous art. As stated above, Friedes appears to disclose a system for processing a database-queried call uses the call processing capabilities of a carrier's database and a subscriber's database as part of a total communication switching system. Friedes describes database-queried communications services as 800 and 900 services which require information look-up in order to route each call. Friedes, therefore, is directed to a system that allows database-queried telephone calls to be efficiently handled and completed using in a cooperative manner, the aggregate call processing capabilities of a subscriber's database and a carrier's database as part of a total communications switching system. Reisman, however, does not relate to database-query call routing. Reisman

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appears to relate to a system for transporting information objects between a user station and multiple remote sources. Therefore, Friedes and Reisman are not in the same field of endeavor. Thus, because Reisman does not in any way relate to telephone call routing, Friedes and Reisman are non-analogous art. Appellants respectfully submit that that the asserted rejection of claim 1 is improper for at least the foregoing reasons.

Claim 2

Claim 2 stands rejected under 35 U.S.C. § 103 (a) as allegedly being unpatentable over Friedes in view of Reisman and further in view of Conklin. Claim 2 depends from claim 1 and is also allowable for at least the foregoing reasons. Claim 2, however, also recites an additional patentable feature of "wherein the search performing means performs the search of the at least one database on a random basis."

Appellants respectfully submit that the rejection of claim 2 is improper for failing to teach or suggest every claimed feature, failing to provide adequate motivation for combining the references, using improper hindsight, and using non-analogous art. As stated above, there is no motivation to combine the references, improper hindsight has been used to arrive at Applicants' claimed invention, and the references are non-analogous art. Friedes is directed to a system for efficiently routing database-queried telephone calls and Reisman is directed to transporting objects between a user station and multiple remote sources. Conklin is directed to a system for conducting negotiations over a network. *See*, Abstract. None of these references are in the same field of endeavor. Therefore, one of ordinary skill in the art would not look to Reisman nor Conklin to modify the system of Friedes.

Claim 2 is considered separately patentable because none of Friedes, Reisman or Conklin appear to disclose a subscription system *"wherein the search performing means performs the search of the at least one database on a random basis."*

Claim 3

Claim 3 stands rejected under 35 U.S.C. § 103 (a) as allegedly being unpatentable over Friedes in view of Reisman and further in view of Conklin. Claim 3 depends from claim 2, which depends from claim 1, and is also allowable for at least the foregoing reasons. Claim 3, however, also recites an additional patentable feature of "wherein the search performing means performs the search on a random basis selected by the user."

Appellants respectfully submit that the rejection of claim 3 is improper for failing to teach or suggest every claimed feature, failing to provide adequate motivation for combining the references, using improper hindsight, and using non-analogous art. As stated above, there is no motivation to combine the references, improper hindsight has been used to arrive at Applicants' claimed invention, and the references are non-analogous art. Friedes is directed to a system for efficiently routing database-queried telephone calls and Reisman is directed to transporting objects between a user station and multiple remote sources. Conklin is directed to a system for conducting negotiations over a network. *See*, Abstract. None of these references are in the same field of endeavor. Therefore, one of ordinary skill in the art would not look to Reisman nor Conklin to modify the system of Friedes.

Claim 3 is considered separately patentable because none of Friedes, Reisman or Conklin appear to disclose a subscription system "*wherein the search performing means performs the search on a random basis selected by the user.*"

Claim 4

Claim 4 stands rejected under 35 U.S.C. § 103 (a) as allegedly being unpatentable over Friedes in view of Reisman and further in view of Freeman. Claim 4 depends from claim 1 and is also allowable for at least the foregoing reasons. Claim 4, however, also recites an additional patentable feature of an "option input means for enabling a user to input one or more options relating to the subscription."

Appellants respectfully submit that the rejection of claim 4 is improper for failing to teach or suggest every claimed feature, failing to provide adequate motivation for combining the references, using improper hindsight, and using non-analogous art. As

stated above, there is no motivation to combine the references, improper hindsight has been used to arrive at Applicants' claimed invention, and the references are non-analogous art. Friedes is directed to a system for efficiently routing database-queried telephone calls and Reisman is directed to transporting objects between a user station and multiple remote sources. Freeman is directed to a method and system for delivering facsimile messages. *See*, Abstract. None of these references are in the same field of endeavor. Therefore, one of ordinary skill in the art would not look to Reisman nor Freeman to modify the system of Friedes.

Claim 4 is considered separately patentable because in combination with the features recited in claim 1, none of Friedes, Reisman or Freeman appear to disclose *"option input means for enabling a user to input one or more options relating to the subscription."*

Claim 5

Claim 5 stands rejected under 35 U.S.C. § 103 (a) as allegedly being unpatentable over Friedes in view of Reisman and further in view of Lambert. Claim 5 depends from claim 1 and is also allowable for at least the foregoing reasons. Claim 5, however, also recites an additional patentable feature of a "subscription formula means for enabling the user to request a subscription using a formula."

Appellants respectfully submit that the rejection of claim 5 is improper for failing to teach or suggest every claimed feature, failing to provide adequate motivation for combining the references, using improper hindsight, and using non-analogous art. As stated above, there is no motivation to combine the references, improper hindsight has been used to arrive at Applicants' claimed invention, and the references are non-analogous art. Friedes is directed to a system for efficiently routing database-queried telephone calls and Reisman is directed to transporting objects between a user station and multiple remote sources. Lambert is directed to a method and apparatus for delivering documents on the Internet. *See*, Abstract. None of these references are in the same field

of endeavor. Therefore, one of ordinary skill in the art would not look to Reisman nor Lambert to modify the system of Friedes.

Claim 5 is considered separately patentable because none of Friedes, Reisman or Lambert appear to disclose a subscription system comprising *"subscription formula means for enabling the user to request a subscription using a formula."*

Claim 6

Appellants respectfully submit that the rejection of claim 6 as allegedly being unpatentable under 35 U.S.C. § 103 (a) over Friedes in view of Reisman is improper for failing to teach or suggest every claimed feature, failing to provide an adequate motivation for combining the references, and using improper hindsight, and using non-analogous art.

Claim 6 recites, *inter alia*, "a subscription requesting object that enables a user to request a subscription of *at least one non-web document* from at least one database, *wherein the subscription identifies information to be searched for and presented to the user at various intervals without additional user intervention.*" Neither Friedes nor Reisman disclose or suggest a subscription that identifies information to be searched for and presented to the user at various intervals without additional user intervention.

As the Office Action, "Friedes does not disclose explicitly indicate 'the subscription identifies information to be searched for and presented to the user at various intervals without additional user intervention.'" Office Action, ¶ 4 (p. 3).

Reisman is relied upon as allegedly disclosing "the user at various interval without additional user intervention." Office Action, ¶ 4 (p. 3). The Office Action refers Appellants' attention to column 10, lines 62-67 and column 11, lines 1-63. Reisman, however, does not appear to disclose a system for providing a subscription to "at least one non-web document" as claimed. Reisman appears to disclose a system for transporting information objects between a user station and multiple remote sources. Any documents, however, that may be transported using the system disclosed in Reisman appear to be in a web format. Reisman states at column 32, lines 30-31, that the content

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type may be "multimedia formats, video formats, sound formats and *hypertext markup language.*" Hypertext markup language is a format used for publishing documents on the WWW. Therefore, any <u>document</u> that is transported using the system disclosed in Reisman appears to be a web document. Thus, Reisman does not appear to disclose a system for providing a subscription to "at least one non-web document" as claimed.

In the Advisory Action, the Examiner states that Applicants do not specifically define what a "non-web document" is in Applicants' specification. Appellants respectfully submit that one of ordinary skill in the art understands what is meant by a "non-web document." As one of ordinary skill in the art is aware, documents may be provided in a format such that the documents may be published on the WWW. For a document to be published on the WWW, the document must be in a format that is viewable by users of the WWW. If a document is not in an acceptable format, users of the WWW are not able to view the document. A document that is viewable to users of the WWW is a web document. Therefore, documents that are not in a format viewable to users of the WWW are non-web documents. Appellants respectfully submit that one of ordinary skill in the art understands this distinction and that Appellants are not attributing any special meaning to the term "non-web document."

Appellants respectfully submit that the rejection of claim 6 is improper because the Friedes and Reisman fail to disclose or suggest at least the claimed feature of *a subscription requesting object that enables a user to request a subscription of at least one non-web document* from at least one database, *wherein the subscription identifies information to be searched for and presented to the user at various intervals without additional user intervention.*

Appellants respectfully submit that the asserted rejection of claim 6 is also improper for failing to provide motivation to combine the teachings of the references. The Office Action alleges that "it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Friedes with the teachings of Reisman so as to have a system for enabling a system user to request a subscription of at least one non-web document from at least one database because the combination would provide an information system with any of multiple electronic

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information object such as e-mail, web page, or non-web document for mass distribute to the requested subscriber as a user (Friedes – col. 5, lines 1-29) in the user to subscribe to updates from information resources environment." Office Action, ¶ 4 (p.5). As evidenced by the reason for combining the teachings of the references, improper hindsight has been used to arrive at Applicants' claimed invention.

Assuming *arguendo* that Reisman cures the deficiencies of Friedes, there is no motivation to combine Friedes and Reisman. Friedes discloses "a system for processing a database-queried call uses the call processing capabilities of a carrier's database and a subscriber's database as part of a total communication switching system." *See*, Abstract. Friedes describes database-queried communications services as "800 and 900 services which require information look-up in order to route each call." Column 1, line 16-18. Friedes, therefore, is directed to "allow database-queried telephone calls to be efficiently handled and completed using in a cooperative manner, the aggregate call processing capabilities of a subscriber's database and a carrier's database as part of a total communications switching system." Column 4, lines 4-8. A subscriber as described in Friedes appears to relate merely to a telephone subscriber. The subscriber may not request a subscription for non-web documents from a database that are search for and presented to the user at various intervals without additional user intervention as claimed. "The subscriber's database uses information from diverse sources to formulate a processing label for the call." Column 4, lines 15-17. Friedes uses information in a database to route a call. This information, however, is not a subscription to which a telephone subscriber may subscribe. Friedes is not directed to a system for providing a subscription to at least one non-web document as claimed.

Reisman, however, appears to relate to a system for transporting information objects between a user station and multiple remote sources. Nowhere does Reisman appear to disclose a system for routing database-queried calls as disclosed by Friedes. One of ordinary skill in the art would not look to Reisman to modify Friedes. Therefore, there is no motivation to combine Friedes and Reisman.

Appellants further respectfully submit that Friedes and Reisman are non-analogous art. As stated above, Friedes appears to disclose a system for processing a

database-queried call uses the call processing capabilities of a carrier's database and a subscriber's database as part of a total communication switching system. Friedes describes database-queried communications services as 800 and 900 services which require information look-up in order to route each call. Friedes, therefore, is directed to a system that allows database-queried telephone calls to be efficiently handled and completed using in a cooperative manner, the aggregate call processing capabilities of a subscriber's database and a carrier's database as part of a total communications switching system. Reisman, however, does not relate to database-query call routing. Reisman appears to relate to a system for transporting information objects between a user station and multiple remote sources. Therefore, Friedes and Reisman are not in the same field of endeavor. Thus, because Reisman does not in any way relate to telephone call routing, Friedes and Reisman are non-analogous art. Appellants respectfully submit that that the asserted rejection of claim 6 is improper for at least the foregoing reasons.

Claim 7

Claim 7 depends from claim 6 and is also allowable for at least the foregoing reasons. Claim 7, however, also recites an additional patentable feature of "wherein the search performing object performs the search of the at least one database on a random basis."

Appellants respectfully submit that the rejection of claim 7 is improper for failing to teach or suggest every claimed feature, failing to provide adequate motivation for combining the references, using improper hindsight, and using non-analogous art. As stated above, there is no motivation to combine the references, improper hindsight has been used to arrive at Applicants' claimed invention, and the references are non-analogous art. Friedes is directed to a system for efficiently routing database-queried telephone calls and Reisman is directed to transporting objects between a user station and multiple remote sources. Conklin is directed to a system for conducting negotiations over a network. *See*, Abstract. None of these references are in the same field of endeavor.

Therefore, one of ordinary skill in the art would not look to Reisman nor Conklin to modify the system of Friedes.

Claim 7 is considered separately patentable because none of Friedes, Reisman or Conklin appear to disclose a subscription system *"wherein the search performing object performs the search of the at least one database on a random basis."*

Claim 8

Claim 8 depends from claim 7, which depends from claim 6, and is also allowable for at least the foregoing reasons. Claim 8, however, also recites an additional patentable feature of "wherein the search performing object performs the search on a random basis selected by the user."

Appellants respectfully submit that the rejection of claim 8 is improper for failing to teach or suggest every claimed feature, failing to provide adequate motivation for combining the references, using improper hindsight, and using non-analogous art. As stated above, there is no motivation to combine the references, improper hindsight has been used to arrive at Applicants' claimed invention, and the references are non-analogous art. Friedes is directed to a system for efficiently routing database-queried telephone calls and Reisman is directed to transporting objects between a user station and multiple remote sources. Conklin is directed to a system for conducting negotiations over a network. *See*, Abstract. None of these references are in the same field of endeavor. Therefore, one of ordinary skill in the art would not look to Reisman nor Conklin to modify the system of Friedes.

Claim 8 is considered separately patentable because none of Friedes, Reisman or Conklin appear to disclose a subscription system *"wherein the search performing object performs the search on a random basis selected by the user."*

Claim 9

Claim 9 stands rejected under 35 U.S.C. § 103 (a) as allegedly being unpatentable over Friedes in view of Reisman and further in view of Freeman. Claim 9 depends from

claim 6 and is also allowable for at least the foregoing reasons. Claim 9, however, also recites an additional patentable feature of an "option input object that enables a user to input one or more options relating to the subscription."

Appellants respectfully submit that the rejection of claim 9 is improper for failing to teach or suggest every claimed feature, failing to provide adequate motivation for combining the references, using improper hindsight, and using non-analogous art. As stated above, there is no motivation to combine the references, improper hindsight has been used to arrive at Applicants' claimed invention, and the references are non-analogous art. Friedes is directed to a system for efficiently routing database-queried telephone calls and Reisman is directed to transporting objects between a user station and multiple remote sources. Freeman is directed to a method and system for delivering facsimile messages. *See*, Abstract. None of these references are in the same field of endeavor. Therefore, one of ordinary skill in the art would not look to Reisman nor Freeman to modify the system of Friedes.

Claim 9 is considered separately patentable because in combination with the features recited in claim 6, none of Friedes, Reisman or Freeman appear to disclose *"option input object that enables a user to input one or more options relating to the subscription."*

Claim 10

Claim 10 stands rejected under 35 U.S.C. § 103 (a) as allegedly being unpatentable over Friedes in view of Reisman and further in view of Lambert. Claim 10 depends from claim 6 and is also allowable for at least the foregoing reasons. Claim 10, however, also recites an additional patentable feature of a "subscription formula receiving object that enables the user to request a subscription using a formula."

Appellants respectfully submit that the rejection of claim 10 is improper for failing to teach or suggest every claimed feature, failing to provide adequate motivation for combining the references, using improper hindsight, and using non-analogous art. As stated above, there is no motivation to combine the references, improper hindsight has

been used to arrive at Applicants' claimed invention, and the references are non-analogous art. Friedes is directed to a system for efficiently routing database-queried telephone calls and Reisman is directed to transporting objects between a user station and multiple remote sources. Lambert is directed to a method and apparatus for delivering documents on the Internet. *See*, Abstract. None of these references are in the same field of endeavor. Therefore, one of ordinary skill in the art would not look to Reisman nor Lambert to modify the system of Friedes.

Claim 10 is considered separately patentable because none Friedes, Reisman or Lambert appear to disclose a subscription system comprising "*subscription formula receiving object that enables the user to request a subscription using a formula.*"

Claim 11

Appellants respectfully submit that the rejection of claim 11 as allegedly being unpatentable under 35 U.S.C. § 103 (a) over Friedes in view of Reisman is improper for failing to teach or suggest every claimed feature, failing to provide an adequate motivation for combining the references, and using non-analogous art.

Claim 11 recites, *inter alia*, "receiving a subscription for *at least one non-web document* from at least one database, *wherein the subscription identifies information to be searched for and presented to the user at various intervals without additional user intervention.*" Neither Friedes nor Reisman disclose or suggest a subscription that identifies information to be searched for and presented to the user at various intervals without additional user intervention.

As admitted in the Office Action, "Friedes does not disclose explicitly indicate 'the subscription identifies information to be searched for and presented to the user at various intervals without additional user intervention.'" Office Action, ¶ 4 (p. 3).

Reisman is relied upon as allegedly disclosing "the user at various interval without additional user intervention." Office Action, ¶ 4 (p. 3). The Office Action refers Appellants' attention to column 10, lines 62-67 and column 11, lines 1-63. Reisman, however, does not appear to disclose a method for providing a subscription to "at least

one non-web document" as claimed. Reisman appears to disclose a system for transporting information objects between a user station and multiple remote sources. Any documents, however, that may be transported using the system disclosed in Reisman appear to be in a web format. Reisman states at column 32, lines 30-31, that the content type may be "multimedia formats, video formats, sound formats and *hypertext markup language*." Hypertext markup language is a format used for publishing documents on the WWW. Therefore, any <u>document</u> that is transported using the system disclosed in Reisman appears to be a web document. Thus, Reisman does not appear to disclose a system for providing a subscription to "at least one non-web document" as claimed.

In the Advisory Action, the Examiner states that Applicants do not specifically define what a "non-web document" is in Applicants' specification. Appellants respectfully submit that one of ordinary skill in the art understands what is meant by a "non-web document." As one of ordinary skill in the art is aware, documents may be provided in a format such that the documents may be published on the WWW. For a document to be published on the WWW, the document must be in a format that is viewable by users of the WWW. If a document is not in an acceptable format, users of the WWW are not able to view the document. A document that is viewable to users of the WWW is a web document. Therefore, documents that are not in a format viewable to users of the WWW are non-web documents. Appellants respectfully submit that one of ordinary skill in the art understands this distinction and that Appellants are not attributing any special meaning to the term "non-web document."

Appellants respectfully submit that the rejection of claim 11 is improper because the Friedes and Reisman fail to disclose or suggest at least the claimed feature of *requesting a subscription for at least one non-web document* from at least one database, *wherein the subscription identifies information to be searched for and presented to the user at various intervals without additional user intervention.*

Appellants respectfully submit that the asserted rejection of claim 11 is also improper for failing to provide motivation to combine the teachings of the references. The Office Action alleges that "it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Friedes with the

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teachings of Reisman so as to have a system for enabling a system user to request a subscription of at least one non-web document from at least one database because the combination would provide an information system with any of multiple electronic information object such as e-mail, web page, or non-web document for mass distribute to the requested subscriber as a user (Friedes – col. 5, lines 1-29) in the user to subscribe to updates from information resources environment." Office Action, ¶ 4 (p.5). As evidenced by the reason for combining the teachings of the references, improper hindsight has been used to arrive at Applicants' claimed invention.

Assuming *arguendo* that Reisman cures the deficiencies of Friedes, there is no motivation to combine Friedes and Reisman. Friedes discloses "a system for processing a database-queried call uses the call processing capabilities of a carrier's database and a subscriber's database as part of a total communication switching system." *See*, Abstract. Friedes describes database-queried communications services as "800 and 900 services which require information look-up in order to route each call." Column 1, line 16-18. Friedes, therefore, is directed to "allow database-queried telephone calls to be efficiently handled and completed using in a cooperative manner, the aggregate call processing capabilities of a subscriber's database and a carrier's database as part of a total communications switching system." Column 4, lines 4-8. A subscriber as described in Friedes appears to relate merely to a telephone subscriber. The subscriber may not request a subscription for non-web documents from a database that are search for and presented to the user at various intervals without additional user intervention as claimed. "The subscriber's database uses information from diverse sources to formulate a processing label for the call." Column 4, lines 15-17. Friedes uses information in a database to route a call. This information, however, is not a subscription to which a telephone subscriber may subscribe. Friedes is not directed to a system for providing a subscription to at least one non-web document as claimed.

Reisman, however, appears to relate to a system for transporting information objects between a user station and multiple remote sources. Nowhere does Reisman appear to disclose a system for routing database-queried calls as disclosed by Friedes.

One of ordinary skill in the art would not look to Reisman to modify Friedes. Therefore, there is no motivation to combine Friedes and Reisman.

Appellants further respectfully submit that Friedes and Reisman are non-analogous art. As stated above, Friedes appears to disclose a system for processing a database-queried call uses the call processing capabilities of a carrier's database and a subscriber's database as part of a total communication switching system. Friedes describes database-queried communications services as 800 and 900 services which require information look-up in order to route each call. Friedes, therefore, is directed to a system that allows database-queried telephone calls to be efficiently handled and completed using in a cooperative manner, the aggregate call processing capabilities of a subscriber's database and a carrier's database as part of a total communications switching system. Reisman, however, does not relate to database-query call routing. Reisman appears to relate to a system for transporting information objects between a user station and multiple remote sources. Therefore, Friedes and Reisman are not in the same field of endeavor. Thus, because Reisman does not in any way relate to telephone call routing, Friedes and Reisman are non-analogous art. Appellants respectfully submit that that the asserted rejection of claim 11 is improper for at least the foregoing reasons.

Claim 12

Claim 12 stands rejected under 35 U.S.C. § 103 (a) as allegedly being unpatentable over Friedes in view of Reisman and further in view of Freeman. Claim 12 depends from claim 11 and is also allowable for at least the foregoing reasons. Claim 12, however, also recites an additional patentable feature of "presenting the information to the user."

Appellants respectfully submit that the rejection of claim 12 is improper for failing to teach or suggest every claimed feature, failing to provide adequate motivation for combining the references, using improper hindsight, and using non-analogous art. As stated above, there is no motivation to combine the references, improper hindsight has been used to arrive at Applicants' claimed invention, and the references are non-

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analogous art. Friedes is directed to a system for efficiently routing database-queried telephone calls and Reisman is directed to transporting objects between a user station and multiple remote sources. Freeman is directed to a method and system for delivering facsimile messages. *See*, Abstract. None of these references are in the same field of endeavor. Therefore, one of ordinary skill in the art would not look to Reisman nor Freeman to modify the system of Friedes.

Claim 12 is considered separately patentable because, in combination with the features of claim 11, none of Friedes, Reisman or Freeman appear to disclose a subscription system *"presenting the information to the user."*

Claim 13

Claim 13 has not been specifically rejected, objected to or allowed. Applicants respectfully request clarification regarding the status of claim 13.

Claim 14

Claim 14 depends from claim 13, which depends from claim 11, and is also allowable for at least the foregoing reasons. Claim 14, however, also recites an additional patentable feature of an "wherein the step of periodically searching the at least one database is performed on a random basis."

Appellants respectfully submit that the rejection of claim 14 is improper for failing to teach or suggest every claimed feature, failing to provide adequate motivation for combining the references, using improper hindsight, and using non-analogous art. As stated above, there is no motivation to combine the references, improper hindsight has been used to arrive at Applicants' claimed invention, and the references are non-analogous art. Friedes is directed to a system for efficiently routing database-queried telephone calls and Reisman is directed to transporting objects between a user station and multiple remote sources. Conklin is directed to a system for conducting negotiations over a network. *See*, Abstract. None of these references are in the same field of endeavor.

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Therefore, one of ordinary skill in the art would not look to Reisman nor Conklin to modify the system of Friedes.

Claim 14 is considered separately patentable because none of Friedes, Reisman or Conklin appear to disclose "wherein the step of periodically searching the at least one database is performed on a random basis."

Claim 15

Claim 15 depends from claim 14, which depends from claim 13, which depends from claim 11, and is also allowable for at least the foregoing reasons. Claim 15, however, also recites an additional patentable feature of a "wherein the step of periodically searching the at least one database is performed on a random basis selected by the user."

Appellants respectfully submit that the rejection of claim 15 is improper for failing to teach or suggest every claimed feature, failing to provide adequate motivation for combining the references, using improper hindsight, and using non-analogous art. As stated above, there is no motivation to combine the references, improper hindsight has been used to arrive at Applicants' claimed invention, and the references are non-analogous art. Friedes is directed to a system for efficiently routing database-queried telephone calls and Reisman is directed to transporting objects between a user station and multiple remote sources. Conklin is directed to a system for conducting negotiations over a network. *See*, Abstract. None of these references are in the same field of endeavor. Therefore, one of ordinary skill in the art would not look to Reisman nor Conklin to modify the system of Friedes.

Claim 15 is considered separately patentable because none of Friedes, Reisman or Conklin appear to disclose a subscription system comprising "wherein the step of periodically searching the at least one database is performed on a random basis selected by the user."

Claim 16

Appellants respectfully submit that the rejection of claim 16 as allegedly being unpatentable under 35 U.S.C. § 103 (a) over Friedes in view of Reisman is improper for failing to teach or suggest every claimed feature, failing to provide an adequate motivation for combining the references, and using non-analogous art.

Claim 16 recites, *inter alia*, "subscription requesting processor readable code for causing a processor to request a subscription of *at least one non-web document* from at least one database, *wherein the subscription identifies information to be searched for and presented to the user at various intervals without additional user intervention.*" Neither Friedes nor Reisman disclose or suggest a subscription that identifies information to be searched for and presented to the user at various intervals without additional user intervention.

As the Office Action, "Friedes does not disclose explicitly indicate 'the subscription identifies information to be searched for and presented to the user at various intervals without additional user intervention.'" Office Action, ¶ 4 (p. 3).

Reisman is relied upon as allegedly disclosing "the user at various interval without additional user intervention." Office Action, ¶ 4 (p. 3). The Office Action refers Appellants' attention to column 10, lines 62-67 and column 11, lines 1-63. Reisman, however, does not appear to disclose a system for providing a subscription to "at least one non-web document" as claimed. Reisman appears to disclose a system for transporting information objects between a user station and multiple remote sources. Any documents, however, that may be transported using the system disclosed in Reisman appear to be in a web format. Reisman states at column 32, lines 30-31, that the content type may be "multimedia formats, video formats, sound formats and *hypertext markup language.*" Hypertext markup language is a format used for publishing documents on the WWW. Therefore, any <u>document</u> that is transported using the system disclosed in Reisman appears to be a web document. Thus, Reisman does not appear to disclose a system for providing a subscription to "at least one non-web document" as claimed.

In the Advisory Action, the Examiner states that Applicants do not specifically define what a "non-web document" is in Applicants' specification. Appellants respectfully submit that one of ordinary skill in the art understands what is meant by a "non-web document." As one of ordinary skill in the art is aware, documents may be provided in a format such that the documents may be published on the WWW. For a document to be published on the WWW, the document must be in a format that is viewable by users of the WWW. If a document is not in an acceptable format, users of the WWW are not able to view the document. A document that is viewable to users of the WWW is a web document. Therefore, documents that are not in a format viewable to users of the WWW are non-web documents. Appellants respectfully submit that one of ordinary skill in the art understands this distinction and that Appellants are not attributing any special meaning to the term "non-web document."

Appellants respectfully submit that the rejection of claim 16 is improper because the Friedes and Reisman fail to disclose or suggest at least the claimed feature of *subscription requesting means for enabling a user to request a subscription of at least one non-web document* from at least one database, *wherein the subscription identifies information to be searched for and presented to the user at various intervals without additional user intervention.*

Appellants respectfully submit that the asserted rejection of claim 16 is also improper for failing to provide motivation to combine the teachings of the references. The Office Action alleges that "it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Friedes with the teachings of Reisman so as to have a system for enabling a system user to request a subscription of at least one non-web document from at least one database because the combination would provide an information system with any of multiple electronic information object such as e-mail, web page, or non-web document for mass distribute to the requested subscriber as a user (Friedes – col. 5, lines 1-29) in the user to subscribe to updates from information resources environment." Office Action, ¶ 4 (p.5). As evidenced by the reason for combining the teachings of the references, improper hindsight has been used to arrive at Applicants' claimed invention.

Assuming *arguendo* that Reisman cures the deficiencies of Friedes, there is no motivation to combine Friedes and Reisman. Friedes discloses "a system for processing a database-queried call uses the call processing capabilities of a carrier's database and a subscriber's database as part of a total communication switching system." *See*, Abstract. Friedes describes database-queried communications services as "800 and 900 services which require information look-up in order to route each call." Column 1, line 16-18. Friedes, therefore, is directed to "allow database-queried telephone calls to be efficiently handled and completed using in a cooperative manner, the aggregate call processing capabilities of a subscriber's database and a carrier's database as part of a total communications switching system." Column 4, lines 4-8. A subscriber as described in Friedes appears to relate merely to a telephone subscriber. The subscriber may not request a subscription for non-web documents from a database that are search for and presented to the user at various intervals without additional user intervention as claimed. "The subscriber's database uses information from diverse sources to formulate a processing label for the call." Column 4, lines 15-17. Friedes uses information in a database to route a call. This information, however, is not a subscription to which a telephone subscriber may subscribe. Friedes is not directed to a system for providing a subscription to at least one non-web document as claimed.

Reisman, however, appears to relate to a system for transporting information objects between a user station and multiple remote sources. Nowhere does Reisman appear to disclose a system for routing database-queried calls as disclosed by Friedes. One of ordinary skill in the art would not look to Reisman to modify Friedes. Therefore, there is no motivation to combine Friedes and Reisman.

Appellants further respectfully submit that Friedes and Reisman are non-analogous art. As stated above, Friedes appears to disclose a system for processing a database-queried call uses the call processing capabilities of a carrier's database and a subscriber's database as part of a total communication switching system. Friedes describes database-queried communications services as 800 and 900 services which require information look-up in order to route each call. Friedes, therefore, is directed to a system that allows database-queried telephone calls to be efficiently handled and

completed using in a cooperative manner, the aggregate call processing capabilities of a subscriber's database and a carrier's database as part of a total communications switching system. Reisman, however, does not relate to database-query call routing. Reisman appears to relate to a system for transporting information objects between a user station and multiple remote sources. Therefore, Friedes and Reisman are not in the same field of endeavor. Thus, because Reisman does not in any way relate to telephone call routing, Friedes and Reisman are non-analogous art. Appellants respectfully submit that that the asserted rejection of claim 16 is improper for at least the foregoing reasons.

Claim 17

Claim 17 depends from claim 16 and is also allowable for at least the foregoing reasons. Claim 17, however, also recites an additional patentable feature of "search performing processor readable code performs the search of the at least one database on a random basis."

Appellants respectfully submit that the rejection of claim 17 is improper for failing to teach or suggest every claimed feature, failing to provide adequate motivation for combining the references, using improper hindsight, and using non-analogous art. As stated above, there is no motivation to combine the references, improper hindsight has been used to arrive at Applicants' claimed invention, and the references are non-analogous art. Friedes is directed to a system for efficiently routing database-queried telephone calls and Reisman is directed to transporting objects between a user station and multiple remote sources. Conklin is directed to a system for conducting negotiations over a network. *See*, Abstract. None of these references are in the same field of endeavor. Therefore, one of ordinary skill in the art would not look to Reisman nor Conklin to modify the system of Friedes.

Claim 17 is considered separately patentable because none of Friedes, Reisman or Conklin appear to disclose a subscription system "*search performing processor readable code performs the search of the at least one database on a random basis.*"

Claim 18

Claim 18 depends from claim 17, which depends from claim 16, and is also allowable for at least the foregoing reasons. Claim 18, however, also recites an additional patentable feature of "wherein the search performing processor readable code performs the search on a random basis selected by the user."

Appellants respectfully submit that the rejection of claim 18 is improper for failing to teach or suggest every claimed feature, failing to provide adequate motivation for combining the references, using improper hindsight, and using non-analogous art. As stated above, there is no motivation to combine the references, improper hindsight has been used to arrive at Applicants' claimed invention, and the references are non-analogous art. Friedes is directed to a system for efficiently routing database-queried telephone calls and Reisman is directed to transporting objects between a user station and multiple remote sources. Conklin is directed to a system for conducting negotiations over a network. *See*, Abstract. None of these references are in the same field of endeavor. Therefore, one of ordinary skill in the art would not look to Reisman nor Conklin to modify the system of Friedes.

Claim 18 is considered separately patentable because none of Friedes, Reisman or Conklin appear to disclose a subscription system *"wherein the search performing means performs the search on a random basis selected by the user."*

Claim 19

Claim 19 stands rejected under 35 U.S.C. § 103 (a) as allegedly being unpatentable over Friedes in view of Reisman and further in view of Freeman. Claim 19 depends from claim 16 and is also allowable for at least the foregoing reasons. Claim 19, however, also recites an additional patentable feature of "option input processor readable code for causing a processor to enable a user to input one or more options relating to the subscription."

Appellants respectfully submit that the rejection of claim 19 is improper for failing to teach or suggest every claimed feature, failing to provide adequate motivation

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for combining the references, using improper hindsight, and using non-analogous art. As stated above, there is no motivation to combine the references, improper hindsight has been used to arrive at Applicants' claimed invention, and the references are non-analogous art. Friedes is directed to a system for efficiently routing database-queried telephone calls and Reisman is directed to transporting objects between a user station and multiple remote sources. Freeman is directed to a method and system for delivering facsimile messages. *See*, Abstract. None of these references are in the same field of endeavor. Therefore, one of ordinary skill in the art would not look to Reisman nor Freeman to modify the system of Friedes.

Claim 19 is considered separately patentable because in combination with the features recited in claim 16, none Friedes, Reisman or Freeman appear to disclose *"option input means for enabling a user to input one or more options relating to the subscription."*

Claim 20

Claim 20 stands rejected under 35 U.S.C. § 103 (a) as allegedly being unpatentable over Friedes in view of Reisman and further in view of Lambert. Claim 20 depends from claim 16 and is also allowable for at least the foregoing reasons. Claim 20, however, also recites an additional patentable feature of a "subscription formula processor readable code for causing a processor to enable the user to request a subscription using a formula."

Appellants respectfully submit that the rejection of claim 20 is improper for failing to teach or suggest every claimed feature, failing to provide adequate motivation for combining the references, using improper hindsight, and using non-analogous art. As stated above, there is no motivation to combine the references, improper hindsight has been used to arrive at Applicants' claimed invention, and the references are non-analogous art. Friedes is directed to a system for efficiently routing database-queried telephone calls and Reisman is directed to transporting objects between a user station and multiple remote sources. Lambert is directed to a method and apparatus for delivering

documents on the Internet. *See*, Abstract. None of these references are in the same field of endeavor. Therefore, one of ordinary skill in the art would not look to Reisman nor Lambert to modify the system of Friedes.

Claim 20 is considered separately patentable because none of Friedes, Reisman or Lambert appear to disclose a subscription system comprising *"subscription formula processor readable code for causing a processor to enable the user to request a subscription using a formula."*

Claim 21

Claim 21 stands rejected under 35 U.S.C. § 103 (a) as allegedly being unpatentable over Friedes in view of Reisman and further in view of Freeman. Claim 21 depends from claim 1 and is also allowable for at least the foregoing reasons. Claim 21, however, also recites an additional patentable feature of an "wherein the at least one database is a Lotus Notes database."

Appellants respectfully submit that the rejection of claim 21 is improper for failing to teach or suggest every claimed feature, failing to provide adequate motivation for combining the references, using improper hindsight, and using non-analogous art. As stated above, there is no motivation to combine the references, improper hindsight has been used to arrive at Applicants' claimed invention, and the references are non-analogous art. Friedes is directed to a system for efficiently routing database-queried telephone calls and Reisman is directed to transporting objects between a user station and multiple remote sources. Freeman is directed to a method and system for delivering facsimile messages. *See*, Abstract. None of these references are in the same field of endeavor. Therefore, one of ordinary skill in the art would not look to Reisman nor Freeman to modify the system of Friedes.

Claim 21 is considered separately patentable because in combination with the features recited in claim 1, none of Friedes, Reisman or Freeman appear to disclose *"wherein the at least one database is a Lotus Notes database."*

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Claim 22

Claim 22 stands rejected under 35 U.S.C. § 103 (a) as allegedly being unpatentable over Friedes in view of Reisman and further in view of Freeman. Claim 22 depends from claim 1 and is also allowable for at least the foregoing reasons. Claim 22, however, also recites an additional patentable feature of a "subscription presenting means for presenting the subscription to the user."

Appellants respectfully submit that the rejection of claim 22 is improper for failing to teach or suggest every claimed feature, failing to provide adequate motivation for combining the references, using improper hindsight, and using non-analogous art. As stated above, there is no motivation to combine the references, improper hindsight has been used to arrive at Applicants' claimed invention, and the references are non-analogous art. Friedes is directed to a system for efficiently routing database-queried telephone calls and Reisman is directed to transporting objects between a user station and multiple remote sources. Freeman is directed to a method and system for delivering facsimile messages. *See*, Abstract. None of these references are in the same field of endeavor. Therefore, one of ordinary skill in the art would not look to Reisman nor Freeman to modify the system of Friedes.

Claim 22 is considered separately patentable because in combination with the features recited in claim 1, none of Friedes, Reisman or Freeman appear to disclose *"subscription presenting means for presenting the subscription to the user."*

Claim 23

Claim 23 stands rejected under 35 U.S.C. § 103 (a) as allegedly being unpatentable over Friedes in view of Reisman and further in view of Freeman. Claim 23 depends from claim 22, which depends from claim 1, and is also allowable for at least the foregoing reasons. Claim 23, however, also recites an additional patentable feature of a "wherein the subscription presenting means presents the subscription as an electronic mail message."

Appellants respectfully submit that the rejection of claim 23 is improper for
failing to teach or suggest every claimed feature, failing to provide adequate motivation
for combining the references, using improper hindsight, and using non-analogous art. As
stated above, there is no motivation to combine the references, improper hindsight has
been used to arrive at Applicants' claimed invention, and the references are non-
analogous art. Friedes is directed to a system for efficiently routing database-queried
telephone calls and Reisman is directed to transporting objects between a user station and
multiple remote sources. Freeman is directed to a method and system for delivering
facsimile messages. *See*, Abstract. None of these references are in the same field of
endeavor. Therefore, one of ordinary skill in the art would not look to Reisman nor
Freeman to modify the system of Friedes.

Claim 23 is considered separately patentable because in combination with the
features recited in claims 1 and 22, none of Friedes, Reisman or Freeman appear to
disclose *"wherein the subscription presenting means presents the subscription as an
electronic mail message."*

Claim 24

Claim 24 stands rejected under 35 U.S.C. § 103 (a) as allegedly being
unpatentable over Friedes in view of Reisman and further in view of Freeman. Claim 24
depends from claim 6 and is also allowable for at least the foregoing reasons. Claim 24,
however, also recites an additional patentable feature of an "wherein the at least one
database is a Lotus Notes database."

Appellants respectfully submit that the rejection of claim 24 is improper for
failing to teach or suggest every claimed feature, failing to provide adequate motivation
for combining the references, using improper hindsight, and using non-analogous art. As
stated above, there is no motivation to combine the references, improper hindsight has
been used to arrive at Applicants' claimed invention, and the references are non-
analogous art. Friedes is directed to a system for efficiently routing database-queried
telephone calls and Reisman is directed to transporting objects between a user station and

multiple remote sources. Freeman is directed to a method and system for delivering facsimile messages. *See*, Abstract. None of these references are in the same field of endeavor. Therefore, one of ordinary skill in the art would not look to Reisman nor Freeman to modify the system of Friedes.

Claim 24 is considered separately patentable because in combination with the features recited in claim 6, none of Friedes, Reisman or Freeman appear to disclose *"wherein the at least one database is a Lotus Notes database."*

Claim 25

Claim 25 stands rejected under 35 U.S.C. § 103 (a) as allegedly being unpatentable over Friedes in view of Reisman and further in view of Freeman. Claim 25 depends from claim 6 and is also allowable for at least the foregoing reasons. Claim 25, however, also recites an additional patentable feature of a "subscription presenting means for presenting the subscription to the user."

Appellants respectfully submit that the rejection of claim 25 is improper for failing to teach or suggest every claimed feature, failing to provide adequate motivation for combining the references, using improper hindsight, and using non-analogous art. As stated above, there is no motivation to combine the references, improper hindsight has been used to arrive at Applicants' claimed invention, and the references are non-analogous art. Friedes is directed to a system for efficiently routing database-queried telephone calls and Reisman is directed to transporting objects between a user station and multiple remote sources. Freeman is directed to a method and system for delivering facsimile messages. *See*, Abstract. None of these references are in the same field of endeavor. Therefore, one of ordinary skill in the art would not look to Reisman nor Freeman to modify the system of Friedes.

Claim 25 is considered separately patentable because in combination with the features recited in claim 6, none of Friedes, Reisman or Freeman appear to disclose *"subscription presenting means for presenting the subscription to the user."*

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Claim 26

Claim 26 stands rejected under 35 U.S.C. § 103 (a) as allegedly being unpatentable over Friedes in view of Reisman and further in view of Freeman. Claim 26 depends from claim 25, which depends from claim 6, and is also allowable for at least the foregoing reasons. Claim 26, however, also recites an additional patentable feature of a "wherein the subscription presenting means presents the subscription as an electronic mail message."

Appellants respectfully submit that the rejection of claim 26 is improper for failing to teach or suggest every claimed feature, failing to provide adequate motivation for combining the references, using improper hindsight, and using non-analogous art. As stated above, there is no motivation to combine the references, improper hindsight has been used to arrive at Applicants' claimed invention, and the references are non-analogous art. Friedes is directed to a system for efficiently routing database-queried telephone calls and Reisman is directed to transporting objects between a user station and multiple remote sources. Freeman is directed to a method and system for delivering facsimile messages. *See,* Abstract. None of these references are in the same field of endeavor. Therefore, one of ordinary skill in the art would not look to Reisman nor Freeman to modify the system of Friedes.

Claim 26 is considered separately patentable because in combination with the features recited in claims 6 and 25, none of Friedes, Reisman or Freeman appear to disclose *"wherein the subscription presenting means presents the subscription as an electronic mail message."*

Claim 27

Claim 27 stands rejected under 35 U.S.C. § 103 (a) as allegedly being unpatentable over Friedes in view of Reisman and further in view of Freeman. Claim 27 depends from claim 11 and is also allowable for at least the foregoing reasons. Claim 27, however, also recites an additional patentable feature of an "wherein the at least one database is a Lotus Notes database."

Appellants respectfully submit that the rejection of claim 27 is improper for failing to teach or suggest every claimed feature, failing to provide adequate motivation for combining the references, using improper hindsight, and using non-analogous art. As stated above, there is no motivation to combine the references, improper hindsight has been used to arrive at Applicants' claimed invention, and the references are non-analogous art. Friedes is directed to a system for efficiently routing database-queried telephone calls and Reisman is directed to transporting objects between a user station and multiple remote sources. Freeman is directed to a method and system for delivering facsimile messages. *See*, Abstract. None of these references are in the same field of endeavor. Therefore, one of ordinary skill in the art would not look to Reisman nor Freeman to modify the system of Friedes.

Claim 27 is considered separately patentable because in combination with the features recited in claim 11, none of Friedes, Reisman or Freeman appear to disclose *"wherein the at least one database is a Lotus Notes database."*

Claim 28

Claim 28 stands rejected under 35 U.S.C. § 103 (a) as allegedly being unpatentable over Friedes in view of Reisman and further in view of Freeman. Claim 28 depends from claim 11 and is also allowable for at least the foregoing reasons. Claim 28, however, also recites an additional patentable feature of a "presenting the subscription to the user."

Appellants respectfully submit that the rejection of claim 28 is improper for failing to teach or suggest every claimed feature, failing to provide adequate motivation for combining the references, using improper hindsight, and using non-analogous art. As stated above, there is no motivation to combine the references, improper hindsight has been used to arrive at Applicants' claimed invention, and the references are non-analogous art. Friedes is directed to a system for efficiently routing database-queried telephone calls and Reisman is directed to transporting objects between a user station and multiple remote sources. Freeman is directed to a method and system for delivering

facsimile messages. *See*, Abstract. None of these references are in the same field of endeavor. Therefore, one of ordinary skill in the art would not look to Reisman nor Freeman to modify the system of Friedes.

Claim 28 is considered separately patentable because in combination with the features recited in claim 11, none of Friedes, Reisman or Freeman appear to disclose *"presenting the subscription to the user."*

Claim 29

Claim 29 stands rejected under 35 U.S.C. § 103 (a) as allegedly being unpatentable over Friedes in view of Reisman and further in view of Freeman. Claim 29 depends from claim 28, which depends from claim 11, and is also allowable for at least the foregoing reasons. Claim 29, however, also recites an additional patentable feature of a "wherein the presenting step presents the subscription as an electronic mail message."

Appellants respectfully submit that the rejection of claim 29 is improper for failing to teach or suggest every claimed feature, failing to provide adequate motivation for combining the references, using improper hindsight, and using non-analogous art. As stated above, there is no motivation to combine the references, improper hindsight has been used to arrive at Applicants' claimed invention, and the references are non-analogous art. Friedes is directed to a system for efficiently routing database-queried telephone calls and Reisman is directed to transporting objects between a user station and multiple remote sources. Freeman is directed to a method and system for delivering facsimile messages. *See*, Abstract. None of these references are in the same field of endeavor. Therefore, one of ordinary skill in the art would not look to Reisman nor Freeman to modify the system of Friedes.

Claim 29 is considered separately patentable because in combination with the features recited in claims 11 and 28, none of Friedes, Reisman or Freeman appear to disclose *"wherein the presenting step presents the subscription as an electronic mail message."*

Claim 30

Claim 30 stands rejected under 35 U.S.C. § 103 (a) as allegedly being unpatentable over Friedes in view of Reisman and further in view of Freeman. Claim 30 depends from claim 16 and is also allowable for at least the foregoing reasons. Claim 30, however, also recites an additional patentable feature of an "wherein the at least one database is a Lotus Notes database."

Appellants respectfully submit that the rejection of claim 30 is improper for failing to teach or suggest every claimed feature, failing to provide adequate motivation for combining the references, using improper hindsight, and using non-analogous art. As stated above, there is no motivation to combine the references, improper hindsight has been used to arrive at Applicants' claimed invention, and the references are non-analogous art. Friedes is directed to a system for efficiently routing database-queried telephone calls and Reisman is directed to transporting objects between a user station and multiple remote sources. Freeman is directed to a method and system for delivering facsimile messages. *See*, Abstract. None of these references are in the same field of endeavor. Therefore, one of ordinary skill in the art would not look to Reisman nor Freeman to modify the system of Friedes.

Claim 30 is considered separately patentable because in combination with the features recited in claim 16, none of Friedes, Reisman or Freeman appear to disclose *"wherein the at least one database is a Lotus Notes database."*

Claim 31

Claim 31 stands rejected under 35 U.S.C. § 103 (a) as allegedly being unpatentable over Friedes in view of Reisman and further in view of Freeman. Claim 31 depends from claim 16 and is also allowable for at least the foregoing reasons. Claim 31, however, also recites an additional patentable feature of a "subscription presenting processor readable code for causing a processor to present the subscription to the user."

Appellants respectfully submit that the rejection of claim 31 is improper for failing to teach or suggest every claimed feature, failing to provide adequate motivation

for combining the references, using improper hindsight, and using non-analogous art. As stated above, there is no motivation to combine the references, improper hindsight has been used to arrive at Applicants' claimed invention, and the references are non-analogous art. Friedes is directed to a system for efficiently routing database-queried telephone calls and Reisman is directed to transporting objects between a user station and multiple remote sources. Freeman is directed to a method and system for delivering facsimile messages. *See*, Abstract. None of these references are in the same field of endeavor. Therefore, one of ordinary skill in the art would not look to Reisman nor Freeman to modify the system of Friedes.

Claim 31 is considered separately patentable because in combination with the features recited in claim 16, none of Friedes, Reisman or Freeman appear to disclose *"subscription presenting processor readable code for causing a processor to present the subscription to the user."*

Claim 32

Claim 32 stands rejected under 35 U.S.C. § 103 (a) as allegedly being unpatentable over Friedes in view of Reisman and further in view of Freeman. Claim 32 depends from claim 31, which depends from claim 16, and is also allowable for at least the foregoing reasons. Claim 32, however, also recites an additional patentable feature of a "wherein the subscription presenting processor readable code presents the subscription as an electronic mail message."

Appellants respectfully submit that the rejection of claim 32 is improper for failing to teach or suggest every claimed feature, failing to provide adequate motivation for combining the references, using improper hindsight, and using non-analogous art. As stated above, there is no motivation to combine the references, improper hindsight has been used to arrive at Applicants' claimed invention, and the references are non-analogous art. Friedes is directed to a system for efficiently routing database-queried telephone calls and Reisman is directed to transporting objects between a user station and multiple remote sources. Freeman is directed to a method and system for delivering

facsimile messages. *See*, Abstract. None of these references are in the same field of endeavor. Therefore, one of ordinary skill in the art would not look to Reisman nor Freeman to modify the system of Friedes.

Claim 32 is considered separately patentable because in combination with the features recited in claims 16 and 31, none of Friedes, Reisman or Freeman appear to disclose "*wherein the subscription presenting processor readable code presents the subscription as an electronic mail message.*"
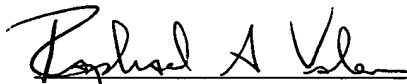
CONCLUSION

Because the cited references, alone or in combination, fail to disclose, teach or suggest all of the features of each pending claim, Appellants respectfully request that the rejection of each of pending Claims 1-32 under 35 U.S.C. §103(a) be reversed.

It is believed that no fees are due in connection with filing this Appeal Brief. In the event that it is determined that fees are due, however, the Commissioner is hereby authorized to charge the undersigned's Deposit Account No. 50-0311.

Respectfully submitted,

MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C.

Raphael A. Valencia
Registration No. 43,216

MINTZ LEVIN COHN FERRIS GLOVSKY AND POPEO, PC
11911 Freedom Drive, Suite 400
Reston, VA 20190
Telephone (703) 464-4800
Facsimile (703) 464-4895

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APPENDIX

1.   A system for enabling a system user to request a subscription of at least one non-web document from at least one database, comprising:

subscription requesting means for enabling a user to request a subscription of at least one non-web document from at least one database, wherein the subscription identifies, information to be searched for and presented to the user at various intervals without additional user intervention;

subscription parameter receiving means for receiving at least one subscription parameter from the user wherein the at least one subscription parameter indicates a type of information to retrieve;

search performing means for performing a search of the at least one database for information matching the subscription; and

subscription retrieving means for retrieving the information matching the subscription.

2.   The system of claim 1, wherein the search performing means performs the search of the at least one database on a random basis.

3.   The system of claim 2, wherein the search performing means performs the search on a random basis selected by the user.

4.   The system of claim 1, further comprising option input means for enabling a user to input one or more options relating to the subscription.

5.   The system of claim 1, further comprising subscription formula means for enabling the user to request a subscription using a formula.

6.   A system for enabling a system user to request a subscription of at least one non-web document from at least one database, comprising:

a subscription requesting object that enables a user to request a subscription of at least one non-web document from at least one database, wherein the subscription identifies information to be searched for and presented to the user at various intervals without additional user intervention;

a subscription parameter receiving object that receives at least one subscription parameter from the user, wherein the subscription parameter indicates a type of information to retrieve;

a search performing object that performs a search of the at least one database for information matching the subscription; and

a subscription retrieving object that retrieves the information matching the subscription.

7.   The system of claim 6, wherein the search performing object performs the search of the at least one database on a random basis.

8.   The system of claim 7, wherein the search performing object performs the search on a random basis selected by the user.

9.   The system of claim 6, further comprising an option input object that enables a user to input one or more options relating to the subscription.

10.   The system of claim 6, further comprising a subscription formula receiving object that enables the user to request a subscription using a formula.

11.   A method for enabling a system user to request a subscription of at least one non-web document from at least one database, comprising the steps of:

requesting a subscription for at least one non-web document from at least one database, wherein the subscription identifies information to be searched for and presented to the user at various intervals without additional user intervention;

receiving at least one subscription parameter from a user, wherein the at least one subscription parameter indicates a type of information to be retrieved;

performing a search of the at least one database for information matching the subscription; and

retrieving the information matching the subscription.

12. The method of claim 11, further comprising the step of presenting the information to the user.

13. The method of claim 11, further comprising the step of periodically searching the at least one database.

14. The method of claim 13, wherein the step of periodically searching the at least one database is performed on a random basis.

15. The method of claim 14, wherein the step of periodically searching the at least one database is performed on a periodic basis selected by the user.

16. A processor readable medium having processor readable code embodied therein for enabling a system user to request a subscription of at least one non-web document from at least one database, comprising:

subscription requesting processor readable code for causing a processor to request a subscription of at least one non-web document from at least one database, wherein the subscription identifies information to be searched for and presented to the user at various intervals without additional user intervention;

subscription parameter receiving processor readable code for causing a processor to receive at least one subscription parameter from a user wherein the at least one subscription parameter indicates a type of information to retrieve;

search performing processor readable code for causing a processor to perform a search of the at least one database for information matching the subscription; and

information retrieving processor readable code for causing a processor to retrieve the information matching the subscription.

17. The medium of claim 16, wherein the search performing processor readable code performs the search of the at least one database on a random basis.

18. The medium of claim 17, wherein the search performing processor readable code performs the search on a random basis selected by the user.

19. The medium of claim 16, further comprising option input processor readable code for causing a processor to enable a user to input one or more options relating to the subscription.

20. The medium of claim 16, further comprising subscription formula processor readable code means for causing a processor to enable the user to request a subscription using a formula.

21. The system of claim 1, wherein the at least one database is a Lotus Notes database.

22. The system of claim 1, further comprising subscription presenting means for presenting the subscription to the user.

23. The system of claim 22, wherein the subscription presenting means presents the subscription as an electronic mail message.

24. The system of claim 6, wherein the at least one database is a Lotus Notes database.

25. The system of claim 6, further comprising subscription presenting means for presenting

the subscription to the user.

26.   The system of claim 25, wherein in the subscription presenting means presents the subscription as an electronic mail message.

27.   The method of claim 11, wherein the at least one database is a Lotus Notes database.

28.   The method of claim 11, further comprising the step of presenting the subscription to the user.

29.   The method of claim 28, wherein the presenting step presents the subscription as an electronic mail message.

30.   The medium of claim 16, wherein the at least one database is a Lotus Notes database.

31.   The medium of claim 16, further comprising subscription presenting processor readable code for causing a processor to present the subscription to the user.

32.   The medium of claim 31, wherein the subscription presenting processor readable code presents the subscription as an electronic mail message.